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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,678	04/10/2001	Tadayuki Suzuki	0425-0821P	3254

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT PAPER NUMBER

1616

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/744,678

Applicant(s)

SUZUKI ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,6-8,13-20 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6,7,16,18,20,27,28 and 30-33 is/are allowed.
- 6) ☐ Claim(s) 1,8,13-15,17,19 and 29 is/are rejected.
- 7) ☐ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

- I. Rejection of claims 1,8,17 will not be maintained under 35 USC 102(b) as being anticipated by JP '010. Applicant has amended claims to include a ratio of component A to component B.
- II. Rejection of claims 1,15,17,29 will not be maintained under 35 USC 102(b) as being anticipated by JP '856. Applicant has amended claims to include a ratio of component A to component F.
- III. Rejection of claims 1,14,17 will not be maintained under 35 USC 102(b) as being anticipated by JP '707. Applicant has amended claims to include a ratio of component A to component E.
- IV. Rejection of claims 1,13,17 will not be maintained under 35 USC 102(b) as being anticipated by JP '185. Applicant has amended claims to include a ratio of component A to component D.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,15,17,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '856. JP '010 teaches a composition comprising **glucose or fructose (B)** plus **sorbitan fatty acid ester (A)**. See abstract. In a claim to a composition the intended use has no patentable significance. In the absence of unexpected results, one having

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ordinary skill would have been expected to determine the optimum ratio of components A:B. One would have been motivated to do this in order to make the most effective composition. It is important to note that in a claim to a composition a statement regarding intended use has no patentable significance.

Claims 1,15,17,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '856. **JP '856** teaches a composition comprising **ethanol or isopropanol (F)** plus 0.1 % **sorbitan fatty acid ester (A)**. See abstract. In a claim to a composition the intended used has no patentable significance. In the absence of unexpected results, one having ordinary skill would have been expected to determine the optimum ratio of components A:F. One would have been motivated to do this in order to make the most effective composition. It is important to note that in a claim to a composition a statement regarding intended use has no patentable significance.

Claims 1,14,17,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '707. **JP '707** teaches a composition comprising **calcium salt (E)** plus **sorbitan fatty acid ester (A)**. See abstract. In a claim to a composition the intended used has no patentable significance. In the absence of unexpected results, one having ordinary skill would have been expected to determine the optimum ratio of components A:E. One would have been motivated to do this in order to make the most effective composition. It is important to note that in a claim to a composition a statement regarding intended use has no patentable significance.

Applicant argues that E makes no claim to a polyvalent metal (calcium or magnesium) of fatty acid. Applicant argues also that "polyoxyethylene sorbitol fatty acid"

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is disclosed in JP '707 not "sorbitol fatty acid ester". Examiner argues that claim 14 recites that E can be a "calcium compound"; therefore, the term "calcium compound" includes calcium fatty acid compounds of the instant claims. Examiner also would like to point out that polyalkylene sorbitol fatty acid esters are also disclosed by the instant claims.

Claims 1,13,17,19,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '185. **JP '185** teaches a composition comprising **semicarbazide (D)** plus **sorbitan fatty acid ester (A)**. See abstract. In a claim to a composition the intended use has no patentable significance. In the absence of unexpected results, one having ordinary skill would have been expected to determine the optimum ratio of components A:D. One would have been motivated to do this in order to make the most effective composition. It is important to note that in a claim to a composition a statement regarding intended use has no patentable significance. Applicant argues the component D does not encompass "semicarbazide". Examiner's refers Applicant to claim 13 line 16 where "semicarbazide" is recited.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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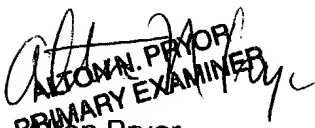
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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